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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,029	03/22/2002	Vicente Bagan Vargas	U013610-2	8633
140	7590	01/13/2004	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			MANLOVE, SHALIE A	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 01/13/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-12

Office Action Summary

Application No.

09/914,029

Applicant(s)

VARGAS ET AL.

Examiner

Shalie A. Manlove

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1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Withdrawn Objections

1. The claim objections in paper 8 have been withdrawn due to Applicant's amendment.
2. The 35 U.S.C. 112 second paragraph rejection over claims 2, 13, and 15-17 are withdrawn due to Applicant's amendment.
3. The 35 U.S.C. 101 rejections over claims 13, and 15-17 are withdrawn due to Applicant's amendment.

Repeat Rejections

4. The 35 U.S.C. 112 first paragraph rejection of claims 2-11 are repeated for reasons previously of record in paper 8.
5. The 35 U.S.C. 112 second paragraph rejection of claim 19 is repeated for reasons previously of record in paper 8.
6. The 35 U.S.C. 102 rejections of claims 1 and 18 are repeated for reasons previously of record in paper 8.
7. The 35 U.S.C. 103 rejection of claim 20 is repeated for reasons previously of record in paper 8.

Applicant is required to list all claims including cancelled claims. See rule 37 CFR 1.121

Election/Restrictions

8. Newly submitted claims 13 and 15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims recite a

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process; and the manufacture of any inorganic pigment using microsilica, which is different from that originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, claims 13 and 15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

New Rejections

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 20 recites the limitation “porcelain stoneware” in line 1. Since it is well known that porcelain and stoneware are two different ceramics, what is porcelain stoneware?

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by

Seabright (US 3,005,724) or Bondioli, F et al Mater. Res. Bull (1998), 33(5), 723-729.

Seabright teaches a pigment of iron oxide-silica comprising 15 – 5% weight iron oxide based on the combined weight of Fe₂O₃ and SiO₂, thus the reference inherently teaches the silica composition to be 95 – 85 % weight. Seabright teaches the pigment to have applications as an

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underglazed ceramic stain in tile. Bondioli teaches silica-iron pigment containing 10-wt % of iron oxide and inherently teaches 90% silica composition. The reference also teaches applications of the pigment for coloring glasses, enamels, unglazed bodies, particularly, glazed and unglazed tiles.

Response to Arguments

13. Applicant's arguments filed October 30, 2003 have been fully considered but they are not persuasive. The references teach the claimed silica-iron oxide pigment including composition, weight percent and uses thereof.

14. Applicant argues that microsilica is processed differently from fume silica of Bondioli or the colloidal silica of Seabright and thus are chemically different.

While microsilica is different from the taught SiO_2 of reference, there is no showing that it makes a different pigment than that taught in the claimed product-by-process claims.

When the prior art discloses a product, which reasonably appears to be either identical with or only slightly different than a product in a product-by process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F. 2d 742, 180 U.S.P.Q. 324 (CCPA 1974).

15. Applicant argues that the claimed process of making the pigment is described in the specification.

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The specification fails to teach all of the processing steps, in particular, blending the majority and minority raw materials, residence time for calcinating the blend, and blending the pigment to obtain a blend of pigment having particles with a particle size.

16. Applicant argues that neither Seabright nor Bondioli teach the claimed pigment.

Seabright and Bondioli clearly teach the pigment composition in addition to applications for coloring ceramic products such as tile and stoneware.

17. Applicant argues neither reference teaches the porcelain stoneware.

The examiner is requesting an explanation or definition of porcelain stoneware.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372.

The examiner can normally be reached on M-F 8:00- 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Shalie A. Manlove
Examiner
Art Unit 1755


C. MELISSA KOSLOW
PRIMARY EXAMINER

January 5, 2003